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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,340	12/12/2003	Adam Gold	506512002100	3740

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MORRISON & FOERSTER LLP
755 PAGE MILL RD
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EXAMINER

MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3734

NOTIFICATION DATE	DELIVERY MODE
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11/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

EOfficePA@mofo.com

Office Action Summary	Application No. 10/735,340	Applicant(s) GOLD ET AL.	
	Examiner MICHAEL G. MENDOZA	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-20 and 38-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-15, 17-20 and 38-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/15/10, 10/27/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/15/2010 has been entered.

Response to Arguments

2. Applicant's arguments filed 9/15/2010 have been fully considered but they are not persuasive. As to claim 40, the applicant has added the new limitation of "said shaft assembly being housed within a deployment tube". The newly added limitation changes the scope of the claim, however the revised interpretation of the prior art to Buelna et al. still reads on the limitation (see new 102(e) rejection below).

3. Applicant's arguments with respect to claims 6-15, 17-20, 38, and 39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 40-42, 45-48, and 50-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Buelna et al. 6620177.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Buelna et al. teaches a device for creating a seal in a blood vessel comprising: a low profile shaft assembly (241), the shaft assembly (241) having an expandable region (figs. 9 & 10) at the distal end of the shaft assembly (241) and a sealing membrane (60, 260) spanning the expandable region, the expandable region being deployable from a first low-profile position to a second expanded position (fig. 1, fig. 3b), the shaft assembly being housed within a deployment tube (250), the deployment tube (250) being movable in relationship to the expandable region such the translational movement of the deployment tube (250) from a first to a second position deploys the expandable region from the first low profile position to the second expanded position (movement of deployment tube 250 towards the expandable region opens the expandable region, while movement of the deployment tube 250 away closes the expandable region); a clamping member (36); a protective shield (260); the expandable region in its second expanded position has a cup shaped configuration (sides and a bottom), where the

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expandable region in its second expanded position has an oval, or a circular shape (see figs.), the expandable region comprises segments that bow outwardly from the shaft assembly (fig. 9, fig. 10); wherein the bowing segments are formed of a slitted (55) flexible tube; wherein the bowing segments are formed of a super-elastic metal memory; wherein the sealing membrane is reinforced; wherein the shaft assembly further comprises a slide (22); wherein translation movement of the slide can be remotely actuated (col. 12, lines 43-47), wherein the expandable region in its second expanded position corresponds to an area of a blood vessel that is large enough to accommodate multiple anastomosis sites (area size is not specified, large enough is relative).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buelna et al.

9. Buelna et al. teaches the method and device of claims 40. It should be noted that Buelna et al. fails to teach wherein the expandable region in its second expanded position has a hexagonal or octagonal shape. However, Buelna et al. does teach that the expandable region contemplates arrangements of other flex point to create bowing that can displace into a variety of patterns. Therefore, it would have been obvious to

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one having ordinary skill in the art at the time the invention was made to modify the device of Buelna et al. to include other flex points that would make the expandable region form other shapes including hexagonal and octagonal as a matter of mere design choice.

10. Claims 6-15, 17-20, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buelna et al. as applied to claims 40-55 above, and further in view of Das 5334217.

11. Buelna et al. teaches a device for creating a seal in a blood vessel as recited in the above 102(e) rejection of claims 40-55. It should be noted that Buelna et al. fails to teach wherein the protective shield has a folded configuration in its non-deployed state. Buelna et al. teaches an elastomeric membrane 260 that would stretch when expanded and shrink when in a non-deployed state.

12. Das also teaches as device for creating a seal using a material folded into a non-deployed state (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Buelna et al. in view of Das to use a membrane that at folded into an non-deployed state as an alternative to an elastomeric membrane since they mechanical expedients and obvious alternatives of each other.

13. Buelna et al. teaches the method and device of claims 40. It should be noted that Buelna et al. fails to teach wherein the expandable region in its second expanded postion has a hexagonal or octagonal shape. However, Buelna et al. does teach that the expandable region contemplates arrangements of other flex point to create bowing

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that can displace into a variety of patterns. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Buelna et al. to include other flex points that would make the expandable region form other shapes including hexagonal and octagonal as a matter of mere design choice.

Allowable Subject Matter

14. Claim 49 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G. M./
Examiner, Art Unit 3734

/TODD E. MANAHAN/
Supervisory Patent Examiner, Art Unit 3776